<u>REMARKS/ARGUMENTS</u>

The Applicants respectfully request further examination and consideration in view of the amendments above and arguments set forth fully below. Claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-52 were previously pending in this application. Within the Office Action, Claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-52 stand rejected under 35 U.S.C. 103(a). Accordingly, Claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-52 are currently pending in this application.

<u>Response to Arguments</u>

The Applicants respectfully submit that the proposed combination of the article titled "Argos Business Solutions: Customer Referral Scheme Encourages Sale of Mobile Phones" (hereinafter "Argos") in view of the article titled "recommend-it.com" (hereinafter "Recommend-It") is improper. However, the Applicants first address the following points raised in the Response to Arguments section of the Office Action.

Point 7

On page 3 of the Office Action, it is recognized that Argos does not specifically teach personalizing the referral or e-mail message, including a serial number for the marketable entity (i.e., mobile phone). The Examiner, however, took Official Notice that serial numbers are unique letters and numbers that are used for identification of a product, hardware or software (UPC barcode), and stated that "the general teachings of using an UPC code/barcode to identify items of the same product, nothing in this general teaching exclude applying it to any item or product, including a particular phone." The Examiner addressed only the Applicants' argument that UPC is a barcode that is the same for items of the same product and, thus, is not unique to identify a particular mobile phone. *However, the Examiner failed to address, in any way, the Applicants' argument of why it is not obvious to a person of ordinary skill in the art to personalize the referral with the UPC.* Particularly, the Applicants previously argued that if the Examiner is indeed describing a truly unique identification associated with each mobile phone, such unique identification, which would be considered private or sensitive information, would not be shared or made public.

According to MPEP 707.07(f), where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the

substance of it. Therefore, the Applicants respectfully request that the Examiner answers the substance of the Applicants' arguments, or otherwise withdraw the rejection.

Point 8

On pages 6 and 7 of the Office Action, the Examiner stated that since "Argos teaches the first party referring the second party, the referral correlating or relating the referral to discounts, merchandises, points are store in a special database that the first users will get for the referral (paragraph 3). The recommendation of the second party is related to the incentives, points, merchandises that the first party will receive for the recommendation and official notice was taken pertaining to a serial number to identify the items therefore the combination of Argos and the official notice taken teaches correlating the first set of data in the first e-mail message to data within a database, the data within the database comprising data related to the reward offer to the first party." However, *the Examiner failed to address, in any way, the claim limitations of correlating the first set of data in the first e-mail message to data within a database.*

The Applicants respectfully submit that it is insufficient for the Examiner to merely address a portion of certain claim elements while remaining silent on remaining portions of the claim elements. Therefore, the Applicants respectfully request that the Examiner provides evidence of every portion of every element of the present invention being taught in the prior art, including the specific limitations of the correlating step, or otherwise withdraw the rejection.

Points 9 and 12

On page 7 of the Office Action, the Examiner stated that "even if the email is saved in a variable or temporary basis as stated [previously] by Applicant, the e-mail address is saved in some sort of storage or database...Even if saving the e-mail address on a permanent database were to be claimed it would have been obvious in order to keep the e-mail addresses for future reference." Applicants respectfully disagree.

Although the Applicants agree with the Examiner's conclusion that the e-mail address in Recommend-It must be stored in some sort of storage, the Applicants submit that the e-mail address is not saved in a database but is saved in a variable. The e-mail address is simply retrieved from the *Email Recipient* field of the form. Nowhere within Recommend-It does Recommend-It teach that the e-mail addresses provided by the user are stored or updated in the database. It is apparent to one skilled in the art that a variable is very different from a database. The Computer Desktop Encyclopedia defines a variable as a structure that holds the data

assigned to it until a new value is assigned or the program is finished. On the other hand, a database is one or more large structured sets of persistent data, usually associated with software to update and query the data.

The Examiner further stated that "even if saving the e-mail address on a permanent database were to be claimed, it would have been obvious in order to keep the e-mail addresses for future reference." The Applicants respectfully disagree. Unlike the present invention where the e-mail addresses of parties are stored because the e-mail addresses are later referenced when rewarding incentives to the parties, the e-mail addresses of visitors need not be saved because Recommend-It is simply informs visitors of a site. It simply provides a notification service. There is no reason to store the visitors' e-mail addresses permanently since the visitors need not later be referenced for any purpose.

The Applicants respectfully submit that the same arguments apply to updating the database with e-mail address of a third party.

According to MPEP 2143.01(VI), if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. Since modifying the cited prior art to include a database would not only change its operation and render it unsatisfactory for its intended purpose, the Recommend-It system would be more complex and expensive. As such, the Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art to save the e-mail addresses in a database, as suggested by the Examiner.

Point 10

On page 8 of the Office Action, the Examiner stated that "[t]he claims do not call for the from field a reply-to field." However, the Applicants are unclear what the Examiner meant by "from field a reply-to field." The Applicants previously argued that a *reply-to field* is different from a *from field*. Although it is illustrated on page of Recommend-It that the e-mail message includes the e-mail address of the first party, that e-mail address is not in the *from field*. Applicants respectfully submit that a *reply-to field* is different from a *from field*. Although the *reply-to field* can contain the same e-mail address as that listed in the *from field*, the *reply-to field* does not necessarily contain the e-mail address of the sender. Unlike the present invention, the first party's e-mail address is in the *reply-to-field*, whereas the *from field* contains an e-mail address of Recommend-It. The principle of operation and the intended purpose of Recommend-

It is for Recommend-It to receive identifying information about the second party from the first party, and for Recommend-It to send an e-mail from the Recommend-It Server and not from the first party.

It is further stated in the Office Action that "it would have been obvious to include the recommender's e-mail address as a reply-to field in order for the recommender to keep track if the party acted favorable to the recommendation." The Applicants respectfully submit the present claims do not recite that the recommender's e-mail address is in the reply-to field; instead, the present claims recite that the recommender's e-mail address is in the from field.

Points 11 and 13

On pages 8-9 of the Office Action, the Examiner again stated that the Recommend-It teaches that e-mail addresses are checked or authenticated and verified since "if not correct or authenticated then the message cannot be sent to the recipient and the sender will receive a message that the message couldn't be delivered to the intended recipient." The Applicants respectfully disagrees.

First, nowhere within recommend-it does recommend-it hint, teach or suggest that any email addresses are confirmed. The Examiner concludes that since an email message will not be successfully delivered to an incorrect email address, email addresses therefore must first be confirmed. *Such clever conclusion that recommend-it first confirms email addresses is to read much more into recommend-it than its actual reading.* The Applicants respectfully submit that there is no need, in recommend-it, to first confirm the email addresses because incorrect email addresses simply result in failed transmissions.

Second, even if email addresses are confirmed or authenticated (they are not), **authentication is not by** *the first party.* Instead, per the Examiner, authentication is by *the recommend-it system.* As such, **authentication is not via an** *authenticating email message* **since the recommend-it system would not send itself an email message**.

Third, since recommend-it does not teach authenticating email message, it therefore follows recommend-it does not teach that the *authenticating email message comprises the first serial number and the email address of the second party.*

Fourth, nowhere within recommend-it does recommend-it hint, teach or suggest that the authentication email message which includes the second party's email address is to enable the second party to access the web site.

According to MPEP 2143.03, all words in a claim must be considered in judging the

patentability of that claim against the prior art. It is not clear to Applicant as to where or how the specific limitations of the authentication by the first party and authenticating email message are disclosed in the cited prior art. Therefore, the Applicant respectfully requests that Examiner either provide evidence in the cited prior art of where these limitations are taught, or otherwise withdraw the rejection.

Claim Rejections – 35 U.S.C. §103(a)

Within the Office Action, claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 are rejected under § 103(a) as being unpatentable over the article titled Argos in view of the article titled recommend-it.com. The Applicants respectfully traverse these rejections.

Independent Claim 1 recites a method of marketing comprising the steps of: providing a referral-based service as part of an electronic communications network and infrastructure and one or more marketable entities to be purchased, wherein the referral-based service and the one or more marketable entities are provided by a Service Provider and any purchase transaction of one of the one or more marketable entities is performed by the Service Provider via the communications network and infrastructure; performing a purchase transaction by the Service Provider, wherein the purchase transaction is related to a first party purchasing a marketable entity via the communications network and infrastructure; offering a reward via the communications network and infrastructure to the first party by the Service Provider in response to the first party purchasing the marketable entity, the reward is in exchange for a recommendation that results in a purchase of the marketable entity by a second party, the recommendation comprising a forwarding of a first e-mail message to the second party, the first e-mail message comprising a personalized referral from the first party for the marketable entity and a first set of data, the first set of data comprising a first serial number and a first URL link to a first Web site of the Service Provider having an offer to transact an exchange for the marketable entity; correlating the first set of data in the first e-mail message to data within a database within the communications network and infrastructure, the data within the database comprising data relating to the reward offered to the first party; updating the database with an e-mail address of the second party provided by the first party; forwarding the first e-mail message to the e-mail address of the second party, wherein the marketable entity is selected from a group consisting of goods and services; and providing the reward to the first party if the second party purchases the marketable entity.

As discussed above, since the cited prior art fails to disclose each and every element of

independent Claim 1 and there is no suggestion or incentive that would have motivated one skilled in the art to modify the prior art to include all of the limitations of independent Claim 1, the Applicants respectfully submit that independent Claim 1 is nonobvious and patentable over the prior art. The Applicants respectfully submit that the same arguments made above with respect to independent Claim 1 are also applicable to the patentability of independent Claims 46 and 50.

Further, the Applicants respectfully submit that the combination of Argos and Recommend-It is improper. The Applicants previously argued:

> Argos teaches a referral program that is designed to reward customers for referring family and friends to DX Communications to purchase a new mobile phone. According to Argos "the DX Collect scheme is a chequebook-based incentive programme. Customers refer colleagues, friends or family to DX by completing a DX Collect cheque with name and address details. Customers then collect points for purchases made by the referee. Discount on DX merchandise, up to GBP 300 worth or Argos vouchers and a GBP 1,000 holiday voucher are amongst the rewards available for between 1 to 40 successful referrals. Points are stored on a special database until customers are ready to select a reward." [Argos, page 1, paragraph 3] No other details are provided as to the implementation of this referral program. Argos provides no details as to the specific steps associated with the referral program. Argos simply teaches a first step where existing customers fill out a DX Collect cheque, and an end result where the referencing party (Customer) collects points for purchases made by the referee. We are left to guess at the intervening steps.
>
> Recommend-it teaches a service whereby a first user can recommend a website to a second user. The recommendation comes in the form of an email sent by the recommend-it service to the second user. To initiate the recommendation, the first user completes a form provided by the recommend-it service. The recommendation form includes an option for the first user to receive a promotional newsletter. Although this option is presented on the same form that the first user fills out to recommend the website, the promotional newsletter is not an actual reward for making the recommendation because the promotional newsletter can be received regardless of whether the first user makes the recommendation.
>
> The Applicants have repeatedly argued that Argos is nothing more than a marketing piece that announces the introduction of a new incentive scheme offered by DX Communications, as implemented by Argos Business Solutions. There are absolutely no details related to either the conceptual implementation details or a physical infrastructure used to implement this incentive scheme. The proposed combination of Argos in view of recommend-it cannot be made with *a reasonable expectation of success* as required under MPEP 2143. The Applicants is unclear as to how the burden of establishing a *prima facie* case of obviousness based on the teachings of Argos and recommend-it has not been met within the Office Action. Therefore, the proposed combination of Argos in view of recommend-it is not proper. [Response filed January 21, 2010]

However, the Examiner failed to address, in any way, the Applicants' argument incorrect. According to MPEP 707.07(f), where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. Therefore, the Applicants respectfully request that the Examiner answers the substance of the Applicants' arguments, or otherwise withdraw the rejection.

Claims 2-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40-41, 43-45 and 52 depend from independent Claim 1. Claims 47-49 depend from the independent Claim 46. Claim 51 depends from the independent Claim 50. Because the dependent claims 2-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40-41, 43-45, 47-49, and 51 are dependent on allowable base claims, they are also allowable.

Further, in regards to Claim 3, the Applicants respectfully submit that neither Argos, recommend-it nor their combination teach the limitation "**the step of updating the database with an e-mail address of the second party is performed through an e-mail field accessed by the first party through a Web browser**" since Argos, recommend-it and their combination fails to teach updating any database, as discussed above. *The Examiner also failed to address, in any way, the Applicants' argument incorrect.* According to MPEP 707.07(f), where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. Therefore, the Applicants respectfully request that the Examiner answers the substance of the Applicants' arguments, or otherwise withdraw the rejection.

Further, in regards to Claim 4, the Applicants respectfully submit that neither Argos, recommend-it nor their combination teach the limitation "**updating the database with an e-mail address of a third party provided by at least one of the first party and the second party**" since Argos, recommend-it and their combination fails to teach updating any database, as discussed above.

Further, in regards to Claim 8, the Applicants respectfully submit that Argos, recommend-it and their combination do not teach the limitation "**forwarding an authenticating e-mail message from the first party to a provider of the first Web site, the authenticating e-mail message comprising a first serial number and the e-mail address of the second party, the authenticating e-mail message thereby enabling the second party to access the first Web site and transact for the marketable entity,**" for at least the reasons discussed above.

Further, in regards to Claim 9, the Applicants respectfully submit that neither Argos, recommend-it nor their combination teach the limitation "**the step of forwarding the first e-**

mail message to the second party and the step of forwarding the authenticating e-mail message to the provider are performed as the result of a single mail command initiated by the first party," for at least the reasons discussed above.

Further, in regards to Claim 52, Office Notice was taken "that it is old and well known to evaluate and determine what items or goods and services are going to be provided before the referral service is provided in order to determine ahead of time and plan for the suitable items, goods or services." The Applicants respectfully disagree and traverse the Examiner's assertion of the official notice. According to MPEP 2144.03, if an applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence. Therefore, Applicants respectfully request evidence to support of the official notice to be produced under the guidelines of MPEP 2144.03.

Conclusion

In view of the foregoing, the Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes that a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact the undersigned at (408) 530-9700.

Respectfully submitted,

HAVERSTOCK & OWENS LLP

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